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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,754	02/13/2002	Daniel L. Marks	OHSU-0015-CN1	1079

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EXAMINER	
CHANDRA, GYAN	

ART UNIT	PAPER NUMBER
1646	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/074,754	**Applicant(s)** MARKS ET AL.	
	Examiner Gyan Chandra	**Art Unit** 1646	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *5 and 6*.
   Claim(s) withdrawn from consideration: *1-4 and 7-15*.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 12/05/2006
13. ☐ Other: _____.

GARY B. NICKOL, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Continuation of 11 does not place the application in condition for allowance because:

Claims 1-15 are pending. Claims 1-4 and 7-15 remain withdrawn from further consideration as being drawn to a nonelected Invention. Claims 5 and 6 are under examination.

Claims 5-6 remain rejected under 35 U.S.C. 102(e) as being anticipated by Cone et al (US Patent No. 6,100,048).

The claims are drawn to a method of preventing a pathological feeding behavior in an animal, the method comprising administering an effective amount of a mammalian melanocortin 4 (MC-4) receptor antagonist to the animal having a pathologica feeding behavior.

Applicants argue (see page 6 of Response) that the screening method of Cone et al would not provide a compound useful for treating cachexia because the pathological conditions of cachexia, result in changes in (i) the basal metabolism in the animal, (ii) lean muscle mass wasting, and (iii) melanocortin receptor activity/binding.

Applicants' arguments have been fully considered but they are not persuasive because Cone et al teach a screening method for identifying compounds with MC-4 receptor antagonist activitiex which are associated with feeding behavior in an animal (abstract and column 5, lines 40-43) and further, they teach that antagonists of the receptor can be used for treating the pathological disorder, cachexia which occurs in cancer patients (column 12, lines 28-30 and col. 25, lines 55-62). Therefore, Cone et al., teach all the limitations of instantly claimed invention. Applicants' arguments that the pathological changes results in the basal metabolism in the animal, lean muscle mass wasting, and melanocortin receptor activity, have been fully considered but they are unpersuasive because applicants are arguing limitations which are not claimed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., basal metabolism in an animal, lean muscle mass wasting and melanocortin receptor binding/activity) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claims 5-6 remain rejected under 35 U.S.C. 102(e) as being anticipated by Dooley et al (US Patent No. 6,350,430).

Applicants argue (see page 7 of Response) that Dooley et al do not relate to any pathological feeding behavior, and argue that Dooley et al do not teach the roles of melanocortin receptors or ligands thereon in an animal having a pathological feeding behavior, such as cachexia.

Applicants' arguments have been fully considered but they are not persuasive because Dooley et al. teach a method of treating cachexia using a MC4R antagonist #P467 (col. 6, lines 34-40, col. 7, lines 60-65, col. 8, lines 50-55). Therefore, Dooley's method of administering a MC-4 receptor antagonist anticipates the instantly claimed method of treating cachexia in an animal. Applicants' argument that Dooley et al do not teach the roles of melanocortin receptors or ligands thereon in an animal having a pathological feeding behavior, such as cachexia has been fully considered but they are unpersuasive because applicants are arguing limitations which are not claimed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., roles of MC4R in an animal having a pathological feeding behavior) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).